

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of: Markus GLOECKLE	Examiner: K. Menon
For: METHOD AND DEVICE FOR PROVIDING A FUEL	Art Unit: 1797
Filed: December 1, 2003	Confirmation No.: 2827
Serial No.: 10/725,858	

Mail Stop Appeal Brief - Patents
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REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

SIR:

This paper is responsive to the "Examiner's Answer" dated March 26, 2008 and the Office communication dated April 21, 2008 in connection with the above-captioned application. For the reasons more fully set forth below and in the "Appeal Brief Pursuant to 37 C.F.R. § 41.37" ("the Appeal Brief"), it is respectfully submitted that the present rejections should be reversed.

Regarding the rejection of claims 1 to 4 and 6 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,149,340 ("Waycuilis"), the Examiner's Answer contends at page 5 of the Examiner's Answer that the Waycuilis discloses a device that is identical to the device disclosed in the present application. For example, the Examiner's Answer asserts that "[t]he device disclosed by the applicant for the purpose of separating aromatics from fuel is also the same as what is taught by the reference – compare applicant's figure 1 (schematic) with that of the reference." This argument appears to assume that all permeable or semi-permeable membranes are identical with regard to what substances are allowed to permeate therethrough. However, the Examiner's Answer has not set forth any basis in fact and/or technical reasoning for this unsupported assumption. Indeed, there is no indication that the membrane of Waycuilis, described as allegedly allowing the permeation of carbon dioxide, water, and sulfur compounds (*see, e.g.*, col. 1, lines 13 to 16), would necessarily allow the

permeation of aromatics. Thus, the assertions of inherency included in the Examiner's Answer are improper. See M.P.E.P. § 2112 (To rely upon a theory of inherency, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."; emphasis in original); *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

Page 8 of the Examiner's Answer conclusorily asserts that "[e]ven if the process is judged as not anticipated by the reference, it is amply obvious to one of ordinary skill in the art." This additional argument must fail, however, for at least the reason that the Examiner has not set forth any rationale consistent with *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007) or in compliance with the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International v. Teleflex Inc.*," 72 Fed. Reg. 57526 (Oct. 10, 2007) ("the Guidelines") and thus has failed to properly establish a *prima facie* case of obviousness. Indeed, a rejection under 35 U.S.C. § 103 has not been made based on Waycuilis. Thus, the contention that "[e]ven if the process is judged as not anticipated by the reference, it is amply obvious to one of ordinary skill in the art" is improper in the present context.

Regarding the rejection of claims 1 to 7 under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,972,093 ("Partridge et al."), the Examiner's Answer at page 9 interprets the "separation device" recited in claim 1 as "an apparatus for separation" and then conclusorily asserts that "[t]he apparatus, or device, of the reference has a scavenging gas acting on it's [sic] permeate side." As an initial matter, as best understood by Appellants, the Examiner impermissibly interprets the claim terms without considering the disclosure of the Specification. See *In re Marosi*, 710 F.2d 799, 218 U.S.P.Q. 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their 'broadest reasonable interpretation'." 710 F.2d at 802, 218 U.S.P.Q. at 292 (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 U.S.P.Q. 464, 466 (C.C.P.A. 1976)) (emphasis in original). In this regard, as previously set forth in the Appeal Brief, the permeate side of the membrane 1101 is not acted upon by a gas. On page 6 of the Examiner's Answer, it is unclear if the Examiner is considering the housing 1100(a) to be part of a "separation device." Regardless, the housing 1100(a) is also not acted upon by a gas within the context of the present application. Rather, any gas that may be present in the low-pressure side chamber 1105 would act upon the liquid layer that effuses across the membrane. Moreover, Appellants traverse the reasoning at pages 9 to 10 of the Examiner's

Answer. As best understood by Appellants, the Examiner's Answer is attempting to establish that because (a) the present application discloses a vacuum pressure on a permeate side of a separation device and/or heating of a fuel feed and (b) Partridge et al. allegedly discloses a vacuum pressure and/or heating of a fuel feed, that Partridge et al. anticipates claim 1. This reasoning directly contradicts what Partridge et al. plainly discloses. That is, that the fuel "effuses to the low-pressure side surface of the membrane 1101, and covers the membrane surface facing the low-pressure side 1105." Col. 3, line 65 to col. 4, line 8. Effusion results in a layer of liquid coating the permeate side. *See, e.g.*, col. 7, lines 23 to 27. This process plainly differs from pervaporation, which is utilized in the present application. Indeed, it is the pervaporation across the separation device that results in the presence of vapor or a gaseous substance at the permeate side. This quality allows the scavenging gas to act upon the separation device at the permeate side thereof in accord with claim 1. In contrast, a gas would only be able to act upon the liquid fuel itself in the context of Partridge et al., as set forth above.

Regarding the rejection of claims 1 to 7 under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent Application Publication No. 2002/0139111 ("Ueda et al."), Applicants traverse any assertions of well known fact and any alleged facts from the personal knowledge of the Examiner. In this regard, the Examiner has not provided any specific evidence to establish those assertions and/or contentions under 37 C.F.R. § 1.104(d)(2) or otherwise.

Further, even if a sweep gas was introduced in the system of Ueda et al. as suggested by the Examiner's Answer, the sweep gas would not act upon the membrane 101, as the permeate side of the membrane 101 is coated with liquid, as Ueda et al. describe an effusion process. *See, e.g.*, page 2, para. 0030.

For at least the reasons indicated above and in the Appeal Brief, Appellants respectfully submit that all of the rejections set forth in the Final Office Action should be reversed.

Respectfully submitted,

Dated: May 27, 2008

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